

REMARKS

Applicants would initially like to thank the Examiner for consideration of Applicants' Information Disclosure Statement as indicated by return of the signed PTO Form-1449.

By the present Office Action, the Examiner has rejected claims 1-3, 15-18, 22, 26 and 27 under 35 U.S.C. § 103 as obvious over Pensak in view of Okamoto. Claims 5-7, 9, 19, 21, 24 and 25 have been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Yaegashi. Claim 4 has been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Okamoto, and further in view of Yaegashi. Claim 8 has been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Yaegashi, and further in view of Chen. Claims 10 and 11 have been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Chen, and further in view of Chen-2. Claims 12-14 have been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Chen. Claim 20 has been rejected under 35 U.S.C. § 103 as obvious over Pensak in view of Okamoto, and further in view of Chen-2. Claim 23 has been rejected under 35 U.S.C. § 103 as obvious over Yaegashi in view of Pensak, and further in view of Jevans.

By the present response, claims 1-27 remain in the application. No claims have been amended or cancelled.

By the present Office Action, the Examiner has rejected all claims based on various combinations of patents. Each such combination includes Pensak, U.S. Patent 6,289,450. Pursuant to 35 U.S.C. § 103 (c), the rejection may not be maintained as a matter of law because (1) Pensak only qualifies as prior art under 35 U.S.C. § 102(e); and (2) Authentica is the common assignee of both Pensak and the instant application.

The instant application was filed on December 15, 2000. At that time, the application that ultimately matured into Pensak was pending before the Patent Office as Serial No.

09/321,839, filed May 28, 1999. Pensak did not issue as a patent until September 11, 2001, well after the filing date of the instant application. Because Pensak was pending when the instant application was filed, Pensak only is capable of qualifying as prior art under 35 U.S.C. § 102(e).

The instant application and the Pensak patent were, at the time of the invention of the instant application, commonly owned by Authentica. A specific statement to that effect from the undersigned as attorney of record appears on the first page of this Response. Pursuant to MPEP § 706.02(l)(2)(II), that statement is sufficient evidence to establish common ownership.

Additional evidence is found in the form of the cover page of the Pensak patent, which identifies Authentica as the assignee of record, and in the assignment documents for the instant application recorded at Reel/Frame 011607/0564. Additional evidence can be provided on request.

Pensak is thus (1) only prior art on under 35 U.S.C. § 102(e), and (2) subject to common ownership by Authentica. Accordingly, pursuant to 35 U.S.C. § 103(c), Pensak is disqualified as prior art for use in an obviousness rejection under 35 U.S.C. § 103. Since all pending rejections are obvious rejections that rely on Pensak, all such rejections cannot be maintained as a matter of law. Withdrawal of all rejections and allowance of the application is therefore warranted and requested.

Applicants note that they strongly disagree with positions taken by the Examiner, particularly with respect to the Examiner's characterizations of Pensak. If substantive discussion were required, Applicants believe that all claims would be shown as patentable without any amendments to the claims. Such discussion is ultimately unnecessary given that the pending rejections cannot be sustained as a matter of law. However, the absence of such discussion is not to be interpreted as any silent admission as to any position taken by the Examiner.

In view of the foregoing, the application is now believed to be in proper form for allowance, and a notice to that effect is earnestly solicited.

If a telephone conference would be of value, the Examiner is requested to call the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293 (Order No. 11696.4011).

Respectfully submitted,



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